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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,688	01/15/2004	Kim R. Smith	163.1836US01	4968
23552	7590	12/21/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			KORNAKOV, MICHAEL	
			ART UNIT	PAPER NUMBER
			1746	
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,688

Applicant(s)

SMITH, KIM R.

Examiner

Michael Komakov

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 1 has been amended by Applicant to change a preamble and to add the limitation that the polishing composition is "...being substantially free of defoaming alcohol", and adding a step of "...leaving glycol on the hard surface to impart gloss". Claims 1-25 are pending. Claims 20-25 are withdrawn from consideration. Claims 1-19 are examined on the merits.

Interpretation of Claims

2. Limitation "...being substantially free of defoaming alcohol" is interpreted in light of the instant specification that allows the defoaming alcohol to be in the following ranges, as stated by Applicant on page 10, lines 24-28 of the instant specification. "The wetting agent or defoaming agent can be present in the composition at about 0 to about 1 wt-%, about 0.1 to about 0.5 wt-%, about 0.035 to about 0.14 wt-%, about 0.02 to about 0.21 wt-%, about 0.015 to about 0.28 wt-%, about 0.01 to about 0.49 wt-%, or about 0.05 to about 0.10 wt-%. The wetting agent or defoaming agent can be present at any of these amounts not as part of a range and/or at any of these amounts not modified by about."

Limitation "...leaving glycol on the hard surface" is interpreted as leaving for ANY possible time from fraction of seconds to minutes or hours.

The limitation "... to impart gloss" is a functional limitation.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1-8, 10 and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Perovetz et al (U.S. 4,925,491).

Perovetz discloses a method of polishing hard surfaces by contacting the hard surface, such as metallic plates (abstract), by contacting it with the composition containing propylene glycol (see col.3, lines 21-25). Polishing compositions comprising propylene glycol and dipropylene glycol in a method of polishing hard surfaces are presented in Examples 1,2,3, and all working examples found in col.6 through col.9. This expressly reads on the limitations of claims 1-6. and 16 With regard to claim 8, the composition of Perovetz is diluted to a proper concentration by water, as can be seen from examples 1-15. With regard to claim 7, Perovetz teaches that the humectant is selected from the group consisting of diethylene glycol, dipropylene glycol and triethylene glycol and serves as a **wetting agent**. In a preferred embodiment, dipropylene glycol is used. Two or more of these compounds may also be used in combination (col.4, lines 44-48).

With regard to claim 10, all working examples of Perovetz explicitly contain either the amount of propylene glycol or the amount of dipropylene glycol or combined amount of two glycols within the claimed range.

5. Claims 1-6, 8, 10 and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sabde (U.S. 6,306,012).

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Sabde discloses a method for polishing hard surfaces (abstract) by contacting it with lubricating planarizing solution (abstract), wherein this solution contains glycerol, polyethylene glycol and polypropylene glycol (col.3, lines 35-50, col.4, lines 55-60).

The composition is exemplified with the content of 5-20% of polyethylene glycol or polypropylene glycol diluted by ammonia and water (see col.5, lines 10, 11). More specific examples in line 30 of col.5 provides for 5% of polypropylene glycol in the polishing composition. See also claim 13 in col.8

6. Claims 1, 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Darcangelo et al (U.S. 6,375,551).

Darcangelo discloses a method of polishing a lithography crystal (hard surface) with cerium composition to achieve defined surface roughness (abstract). A polishing environment such as about 50% water and 50% ethylene glycol provides for slowing of the cerium polish chemical reactivity by lowering its water content (col.7, lines 58-67, col.8, lines 1-5). The composition is free of defoaming alcohol.

7. Claims 1-6, 8-13, 16-18 are rejected under 35 U.S.C. 103(a) as being anticipated by US 2005/0126630 A1 to Swan.

In the teaching of Swan the hot and cold water ***pipng systems*** (reads on hard surface) are protected (polishing is defined by surface protection, see page 2, lines 23, 24) from freezing temperatures. Swan has found that a ratio of **50%**

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propylene glycol is suitable for protecting the surfaces of the system to a temperature of about -50 F (see 0023 and 0033). With regard to imparting gloss, as per the instant claim 1, since the composition and method steps of Swan are substantially the same as claimed, the outcome of imposing such steps would be identical to the instantly claimed. It is axiomatic that one who performs the steps of the known process must necessarily produce all of its advantages. Mere recitation of a newly discovered function or property, that is inherently possessed by things in the prior art does not cause a claim drawn to these things to distinguish over the prior art, consult *Leinoff v. Louis Milona & Sons, Inc.* 220 USPQ 845 (CAFC 1984).

8. Claims 1-16, 18, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 4,978,469 to Seaman.

A hard surface cleaning method is disclosed using a composition formulated for cleaning sub-freezing surfaces without solidifying, comprising: about 20-70 wt-% water, about 0.5-20 wt-% nonionic surfactant such as ethoxylated alkyl phenols, about 0.5-15 wt-% alkaline compound such as sodium hydroxide, **about 10-60 wt-% ethylene and/or propylene glycol**, and about 0.5-20 wt-% of at least one C2-3 alcohol (abstract, col.1, lines 65-68). 0.5% of alcohol is the amount allowed by the instant specification for the composition to be "substantially free of defoaming alcohol" Table 4 in col.3 provides for using a composition containing 45% and 50% of propylene glycol. See also table of examples 1 and 2 in col.4, wherein 405 of propylene glycol is used. The steps of

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the method are described in col.4, lines 55-65, that also addresses the limitations of claims 14 and 19.

9. Claims 1 and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over CN 1329121 A to Liang.

Liang discloses a method of application of rubber tire protecting agent. It is made up by using the ingredients of glycol, polyvinyl alcohol, glycerine, diacetyl cellulose ester, sodium benzoate, cupric sulfate, talcum powder, cellulose and water through the procedures of dissolving, stirring and heating, etc. This rubber type protecting agent possesses the advantages of good flowability, self-repairing quickness and firmness and wide application temperature range, so that it is applicable **to safety protection** of inflatable rubber tire (see abstract). Since the composition of polishing is substantially the same as claimed and the steps of the process are substantially the same in Liang as in the instant claims one skilled in the art would have found obvious that such method and composition will impart the shininess (gloss) to the tire with the reasonable expectation of success.

Response to Arguments

10. Applicant's arguments filed 10/06/2005 have been fully considered but they are not persuasive.

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Seaman reference: Applicants argument resides in contention that Seaman uses at least one C2-3 alcohol, while the instant claims call for “substantially free of defoaming alcohol”. This is not found persuasive for the following reasons:

a) the instant specification NOWHERE provides the statement that composition is “substantially free of defoaming alcohol”, however b) “substantially free of defoaming alcohol” is explained in lines 24-28 of page 8, wherein the concentration of defoaming agent of 0.5% is allowed. This is a concentration that named by Seaman, 0.5-20 wt-% of at least one C2-3 alcohol (abstract, col.1, lines 65-68). Therefore, such concentration that is interpreted as being substantially free of defoaming alcohol is anticipated by Seaman.

Perovetz reference: The crux of Applicants’ arguments is that Perovetz does not disclose a method of imparting gloss to a hard surface, i.e. Applicants argue about the patentable weight of preamble. This argument is not found persuasive for the following reasons:

a) throughout the entire patent Perovetz discloses a method of POLISHING silver items, even the title includes such term. The commonest meaning of polishing provided by dictionaries is “**Polishing** to make or become smooth and glossy by rubbing” “Polish... a smooth shiny finish; a gloss” (see attachment) Therefore, Perovetz not only anticipates the steps of the process, but even anticipates the preamble.

Sabde reference: Applicants submit that Sabde discloses the use of abrasive materials. Specifically, the Sabde reference discloses a chemical- mechanical planarizing process used to remove material from a substrate to create a high

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planar surface. In contrast, the presently claimed invention recites a method of imparting gloss on a hard surface by applying a composition including glycol. The presently claimed method of imparting gloss does not abrasively remove material from a substrate. This argument is not found persuasive for the following reasons:

a) The instant claims use the word "comprising" that is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

b) Sabde does disclose the method for polishing hard surfaces (abstract) by contacting it with lubricating planarizing solution (abstract),

Darcangelo reference: The same rationale as applied in the Sabde reference is incorporated herein. It is further noted that in the argument Applicant fully relies on the preamble. In the instant case the reference does disclose the process of polishing, and, thus discloses the method of imparting shininess or gloss, as defined by the dictionaries above. It is further noted that on the other hand, a preamble is generally not accorded any patentable weight where it merely recites

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the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976).

CN 1329121 reference to Liang: The rejection is changed from 102 to 103 in light of Applicants' amendment.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00am - 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Kornakov
Primary Examiner
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12/15/2005